

### REMARKS

Applicant respectfully requests entry of the amendments and remarks submitted herein. Claims 1-20 are pending and were rejected by the Examiner under various grounds of anticipation and/or obviousness, each of which are discussed below.

The amendments to claims 1, 18, 19, and 20 introduce no new matter. Support for the amendments to claims 1 and 18, and 19 appears in the specification as filed, for example, in Fig. 7, and on page 13, lines 16-30. Support for the amendments to claim 20 appears in the specification as filed, for example, at page 10, lines 8-23; page 11, lines 24-32; page 12, lines 20-22; and page 13, lines 12-15. Claims 21-23 are added to more completely claim the invention, and are supported, for example, by the same disclosure just cited.

Reconsideration of the pending application is respectfully requested.

#### Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1, 6, 19, and 20 under 35 U.S.C. § 102(b) as being anticipated by Wakako Japanese Patent No. 61-184031. Claims 1, 19, and 20 are independent, while claim 6 depends on claim 1.

Applicant contends that the claims, as amended, are each patentably distinguishable from Wakako. Claims 1, as amended, recites a telephone set comprising a "message alert and retrieval device," which further comprises a message key and a light source. As claimed, the "light source causes emission of visible light from the message key." As explained in the specification, the provision of visible light from the message key itself, rather than from some area outside the message key, provides a "compact and intuitive user interface" that has many advantages, including particular advantages in low-light conditions where many telephone sets (including especially hotel telephones and cellular telephones) are used. *See* page 7, line 30 to page 8, line 32.

Nothing in Wakako teaches or even suggests the integration of the light into the message retrieval button itself. Rather, the abstract merely states that a lamp is "accessoried to" a message registration button, thus merely indicating that the two have some sort of functional relationship. And the patent figures indicate that the two are not integrated; the message

registration button is shaded in the figure, and labeled 14, while there is no label for the lamp. There is, however, an unshaded item above the shaded message registration button. Even if one assumes that this is the lamp, the shading on the button and lack of shading on the lamp clearly indicates that the two do not overlap and are not integrated in any way, but are instead just next to each other. Thus, this arrangement is simply the prior art arrangement discussed and distinguished by Applicant, where the lamp is not part of the button. Such an arrangement does not provide the benefits discussed in the patent, and does not meet the limitations of claim 1. In sum, Wakako does not disclose or even suggest a message key that emits light, and thus does not offer the benefits of the Applicant's invention.

Moreover, Wakako does not disclose a "message alert and retrieval device" at all. Claim 1 recites a "message alert and retrieval device" that comprises a "message key operably couple to [a] dialing interface" that "generates a message retrieval control signal in response to activation of the message key." In contrast, the message *registration* button in Wakako simply causes the extension number of a call and the time of the call to appear on a display section 13. The button does not retrieve any message at all. Thus, it is not a retrieval device, and it certainly does not generate a message retrieval control signal. Also, although the Examiner is correct that a telephone needs a dialing interface, nothing in Wakako suggests that the message registration button is connected to the dialing interface, or would even need to be, since the button merely causes a number and time to be displayed and does not cause a message to be retrieved.

Because each of these features is an explicit requirement of claim 1 and Wakako does not disclose or even suggest them, it cannot anticipate.

Claim 6 depends on claim 1, and further recites that the dialing interface generates a DTMF signal. For the reasons stated above, Wakako cannot anticipate claim 6. In addition, because the message registration button of Wakako does not retrieve any messages, but merely causes the display of a number and time, it does not by inherency generate a DTMF signal.

Claim 19, as amended, recites a light source and a key that causes transmission of a message retrieval signal, "wherein the light source is physically integrated with the key." Claim 20 also recites that the light and key are integrated. Again, as noted above, at best, the lamp and button in Wakako are separate, and are not physically integrated. Furthermore, regarding claim 19, Wakako does not disclose or suggest, either expressly or inherently, the generation of a

message retrieval signal, because it does not retrieve a message at all. And for the same reason, Wakako does not disclose or suggest a "message access key," as required by claim 20. For these reasons, Wakako does not anticipate claims 19 or 20.

As a result, the Applicant respectfully requests consideration of the rejection of claims 1, 6, 19, and 20.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 2-5, 7, and 8 under 35 U.S.C. § 103(a) as being unpatentable over Wakako in view of Sakurai et al., U.S. Patent No. 5,586,172, and further in view of Kanzawa, U.S. Patent No. 5,535,262.

As an initial matter, each of these claims depends on claim 1, and therefore they each recite a "light source [that] causes emission of visible light from the message key." They also recite a "message alert and retrieval device." As noted above, Wakako does not teach or even suggest such structures. As to the former, Wakako teaches the opposite even if it is given its most liberal reading. In particular, even if the device above the message registration button in Wakako is the lamp, Wakako simply shows light being emitted *outside* the button, and not from the button. As noted above, Wakako therefore does not provide the advantages discussed at length regarding the Applicant's invention. Moreover, the button in Wakako does not act to retrieve any messages, as noted above, and nothing in Wakako suggests that the limited functionality of the button in Wakako should be modified so as to meet the requirements of Applicant's claims.

Sakurai and Kanzawa do not cure the deficiencies in Wakako. The Examiner cites these references as teaching that the retrieval control signal comprises a predetermined series of dialing digits (for claim 2), a microcomputer inherently having memory (for claims 3 and 4), a PBX system and telephone line connection (for claims 5 and 7), and a message button that is one of the dialing keys (for claim 8). With respect to claim 2, none of the three references discloses or suggests a "message alert and retrieval device," or such a device integrated with a light for indicating the presence of a message, as discussed above.

Regarding claims 3 and 4, the Examiner relies on Kanzawa, but that reference is also deficient. In particular, Kanzawa merely describes a system for recording telephone conversations (such as portions of an ongoing telephone call with another party); it does not deal with retrieval of messages, such as in a voice mail system, and it distinguishes voice mail systems in the Background of the Invention. Thus, although Kanzawa is cited as teaching a "function key 25, [that] if pressed, generates a message retrieval request (column 5, lines 18-24)," (Office Action, at 4), the reference actually says nothing about message retrieval. Instead, the cited portion of Kanzawa merely discusses ways in which a conversation can be recorded; it says nothing about a "message retrieval control signal" whether explicitly or implicitly. Indeed, Kanzawa is concerned with an entirely different problem than the Applicant's invention or any of the prior art, and thus could not suggest a solution to the problem to which Applicant's claims are addressed.

Regarding claims 5 and 7, the Examiner again relies on Kanzawa, but again, Kanzawa fails to disclose the claimed invention. As noted above, claims 5 and 7 (through claim 1) recite a "message alert and retrieval device" comprising a "message key" and the generation of a "message retrieval control signal." As just noted, Kanzawa discusses the recording of telephone conversations, and not the retrieval of messages. There is simply nothing in Wakako or Kanzawa that would suggest the invention as claimed.

Finally with regard to claim 8, the Applicant's claims recite a message alert and retrieval device, not merely a message button that has nothing to do with retrieving messages. As noted above, Wakako does not disclose or suggest such a device. Furthermore, the Examiner merely states that Wakako could be "modified by Sakurai and Kansawa" so as to disclose a system in which the message key is one of the dialing buttons. *See* Office Action, at 5. There is no citation to any disclosure, however, in either reference that would suggest such a modification, and the Applicant has been unable to find any. And in any event, claim 8, like the other claims, recites a "message key" and a "message retrieval control signal." As noted above, none of the three references discloses message retrieval, and they definitely do not disclose or even suggest it in the way claimed by the Applicant.

Moreover, there has been no motivation identified to alter or combine any of the references so as to produce the claimed invention, even though motivation to combine is an

explicit requirement in any obviousness analysis. *See, e.g., In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). Rather, in each instance, the conclusion has simply been reached that it would have been obvious to modify Wakako in one way or the other. Applicant has searched the references for any such motivation, and cannot find one. As a result, not only do the references fail to teach each of the limitations of the pending claims, they do not even provide a motivation to modify any reference or combine multiple references.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejections.

#### Rejections under 35 U.S.C. § 103

The Examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Wakako in view of Tremmel, U.S. Patent No. 5,409,239. Claim 9 recites that the message key comprises a touch-sensitive button, and the Examiner cites Tremmel as disclosing a touch-sensitive video game controller with touch sensitive buttons. As an initial matter, the Examiner has not shown how a video game controller can even be considered relevant or analogous art to a telephone. *See Jurgens v. McKasy*, 927 F.2d 1552, 18 USPQ2d 1031 (Fed. Cir. 1991) (nothing that nonanalogous art "has no bearing on the obviousness of the patent claim."). Additionally, neither Wakako nor Tremmel disclose or suggest the limitations incorporated in claim 9 from claim 1, discussed above. More importantly, the video game controller in Tremmel does not generate *any* sort of telephone-related signal, and definitely does not disclose or suggest a message retrieval signal. Finally, as before, no motivation to combine the Tremmel device with Wakako has been shown. Indeed, at its broadest, Trammel suggests that his device can be used with various video game systems, but he says nothing about the desirability of using it outside simple motion control apparatuses. And Wakako has no disclosure that would suggest that any other type of control mechanism than that disclosed in the Wakako patent should be used. The Examiner's statement that the references suggest that the "message button *could be* a touch sensitive one" does not indicate that there is any motivation that the buttons in Wakako *should be* modified in any way or combined with Trammel. There simply is no motivation to combine these two references which are in wholly disparate fields.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejection.

Rejections under 35 U.S.C. § 103

The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Wakako in view of Burgess, U.S. Patent No. 6,031,465. Claim 10 recites that the message key comprises a membrane switch, and the Examiner cites Burgess as disclosing a keyless entry system for vehicles that uses a membrane switch with a backlight. *See* Office Action, at 6. This attempted combination, however, fails to render claim 10 obvious for the same reasons that the combination of Wakako and Tremmel do not render claim 9 obvious. In particular, Burgess does not involve an analogous area of art, and it does not even address the same or a similar problem as Wakako or the present invention. Indeed, Burgess describes his challenge as the “problem of keyless entry.” In addition, no motivation has been identified in either reference to make a combination or to modify one of the references so as to form the invention of claim 10. And again, neither reference discloses the limitations incorporated in claim 10 from claim 1, discussed above.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejection.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 11 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Wakako in view of Kavanaugh et al., U.S. Patent No. 6,223,233. Claim 11 states that the message key comprises a graphical icon, while claim 17 recites that the light source comprises a liquid crystal display element. The Examiner cites Kavanaugh as a wallet for a personal information device which has a touch-sensitive liquid-crystal display by which a user can select an icon to “implement the corresponding organizer feature.” But Kavanaugh, like the other putative prior art references, has nothing to do with retrieving messages in a telephone system, and is, therefore, nonanalogous (and therefore irrelevant) art. And as before, the limitations of claim 1 (which are part of dependent claims 11 and 17) are not disclosed at all by any of the

references. In addition, no motivation has been shown to modify Wakako (even if it were assumed to disclose the other claim limitations) using the teachings of Kavanaugh.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejections.

Rejections under 35 U.S.C. § 103

The Examiner rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Wakako, Japanese Patent No. 61-184031. Claim 12 recites that the light source is located directly beneath the message key of claim 1, and the Examiner cites Wakako as disclosing a push-button switch with a built-in lamp as its light source to activate a message control signal. However, as discussed above, Wakako does not indicate in any way that the button has a built-in lamp at all. Rather, it simply says that a lamp is "accessoried" to the button, and the figure in Wakako indicates that the light is at most next to the button, and is not built-in. Because the premise (i.e., that Wakako discloses a built-in lamp) is incorrect, the conclusion of obviousness cannot follow. Indeed, as discussed fully above, the telephone shown in Wakako does not disclose or suggest a light that is integrated with a button, and does not provide for message retrieved.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejections.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 13 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Wakako in view of McPherson et al., U.S. Patent No. 5,952,731. Claim 13 recites that the light source of claim 1 comprises an LED, while claim 14 (which depends on claim 13) additionally recites that the LED is mounted below an upper surface of the message key. The Examiner cites McPherson as teaching a keyless entry system for vehicles that has LEDs mounted below the upper surfaces of the switches in the system. Yet again, McPherson comes from a totally nonanalogous field of art. Also, no motivation of any type has been identified in

either Wakako or McPherson that would direct someone to combine the two references, or to modify Wakako as suggested by the Examiner. At best, any such combination would be improperly dependent on the hindsight produced from seeing the Applicant's claimed invention. *See, e.g., In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) (faulting the Examiner and Board for falling into the "hindsight trap."); *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Not only are the lights in McPherson used in an entirely different application, but they are used in an entirely different way, namely, the lights are not used to indicate the occurrence of some event, but are instead simply lit indiscriminately for backlighting purposes.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejections.

#### Rejections under 35 U.S.C. § 103

The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Wakako in view of Charlier, U.S. Patent No. 5,153,590. Claim 15 recites that the light source of claim 1 comprises an LED and light pipe assembly, and the Examiner cites Charlier as disclosing a light pipe assembly with LEDs. Again, however, neither Wakako nor Charlier discloses or suggests the limitations of claim 15 that are incorporated from claim 1 (as discussed repeatedly above), and again the Examiner has not cited a motivation in either reference to combine.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejection.

#### Rejections under 35 U.S.C. § 103

The Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Wakako in view of Akiyama, U.S. Patent No. 5,153,906. Claim 16 recites that the light source of claim 1 comprises a matrix display element, and the Examiner cites Akiyama as disclosing that the status lamp on a telephone can be replaced by a matrix display to indicate the name of a recipient of a speed-dial key. *See Office Action*, at 10. Again, however, no motivation to modify Wakako with the teachings of Akiyama has been shown. In fact, Akiyama's matrix display deals only with the label (61) that might be applied adjacent to a speed-dial button (62),



but says nothing about using a matrix as part of the button itself. Thus, it cannot add anything to Wakako, because it fails to render the claim obvious for all of the reasons that Wakako initially failed to render claim 1 obvious. In addition, the use of a persistant label (i.e., that continuously displays the name of a person) does not suggest the use of a matrix display to indicate the occurrence of an event (e.g., the arrival of a voice mail message). And again, nothing in Akiyama cures the original deficiencies in Wakako—i.e., the failure to disclose or even suggest a message alert and retrieval device, a message key, or the generation of a message retrieval signal.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejection.

Rejections under 35 U.S.C. § 103

The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Wakako, Japanese Patent No. 61-184031 in view of Kanzawa, U.S. Patent No. 5,535,262. Claim 18 is an independent claim that recites a telephone set comprising a “message alert and retrieval device,” a “message key connected to [a] dialing interface,” and the generation of a “message retrieval control signal in response to activation of the message key.” Claim 18 also recites a transmitter and a receiver. The Examiner cites Wakako as disclosing all the claim elements except the use of a transceiver inside the telephone housing. The Examiner cites Kanzawa as disclosing an interface circuit 28 that acts as a transceiver.

Again however, the prior art does not disclose or even suggest the elements of the claimed invention. Claim 18, like claim 1 before it, recites limitations relating to message retrieval. As discussed above, Wakako has a “message registration button” that brings up a phone number and a time, but it does not retrieve a message. In the Office Action, the “message registration button” is referenced simply as a “message button,” but is is not a button that generates a message retrieval signal. Moreover, claim 18 (like claim 1) recites that visible light is emitted from the message key, but Wakako merely states that the a lamp is “accessorized” to the message registration button, thus merely indicating that the two have some sort of functional relationship. Wakako does not show light coming from the button, and as discussed above, merely shows the type of prior art arrangement that the Applicant distinguished in his

application. Finally, no motivation to modify Wakako to produce the device of claim 18 (or to modify Kanzawa or combine the references) has been identified, and none appears to exist.

For each of these reasons, the Applicant respectfully requests reconsideration of the rejection.

In addition, for the reasons discussed above for claim 1, the inventions of new claims 21-23, which depend on claim 1, are neither disclosed nor suggested by any of the references, either alone or in combination.

The Examiner also indicates that a document referring to Panasonic model KX-T7130 is considered pertinent to Applicant's disclosure. Filed with this Response is an Information Disclosure Statement containing on other Panasonic telephones. None of the documents discloses or suggests a message key that has a distinct visual impression, apart from its emission of light, compared to its adjoining keys. Rather, on each pictured Panasonic telephone, the button labeled for messages is simply one of a number of similarly-shaped buttons that form a grid. For this reason, the Panasonic telephones do not provide the full benefit, discussed at length in the patent application, of a compact and intuitive interface, by which the message key is extremely easy to locate. As a result, no reference teaches or suggests the telephone sets cited in claims 1-19 and 21-23 (as amended).

Furthermore, the Panasonic message button is, for the most part, a solid bar that does not light up. Only a relatively minor portion of the button at one end of the bar emits any light at all. In contrast, amended claim 20 recites a telephone comprising a message indicator light and message access key, wherein the key's upper surface emits light from its substantial entirety. Again, the Panasonic telephone sets do not provide a simple, intuitive interface in which the message key is conspicuous and extremely easy to locate.

Attached is a marked-up version of the changes being made by the current amendment.

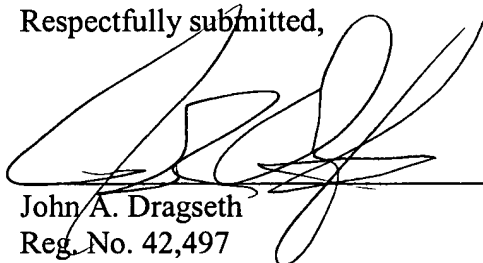
Applicant : Dale Pelletier  
Serial No. : 09/281,396  
Filed : March 30, 1999  
Page : 14

Attorney's Docket No.: 10569-002001

Applicant asks that all claims be allowed. Enclosed is a \$54 check for excess claim fees and a \$460 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 8/28/02

  
John A. Dragseth  
Reg. No. 42,497

Fish & Richardson P.C., P.A.  
60 South Sixth Street  
Suite 3300  
Minneapolis, MN 55402  
Telephone: (612) 335-5070  
Facsimile: (612) 288-9696

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**Version with markings to show changes made**

**In the claims:**

Claims 1, 18, 19, and 20 have been amended as follows:

1. A telephone set comprising:
  - a) a housing;
  - b) a dialing interface mounted in the housing, the dialing interface being in communication with a call management interface;
  - c) a plurality of dialing keys operably connected to the dialing interface; and
  - d) a message alert and retrieval device, comprising a message key operably connected to the dialing interface, and a light source that causes emission of a visible light from the message key, wherein the dialing interface generates a message retrieval control signal in response to activation of the message key, and wherein the light source is responsive to a message waiting signal generated by the call management interface,  
the message key having a distinct visual impression, apart from its emission of visible light, compared to its adjoining keys.

18. A telephone set, comprising:
  - a) a housing;
  - b) a dialing interface mounted in the housing;
  - c) a plurality of dialing keys attached to the housing and operably connected to the dialing interface;
  - d) a transceiver electrically connected to the dialing interface and in communication with a call management interface;
  - e) a message alert and retrieval device attached to the housing, comprising a message key operably connected to the dialing interface, and a light source that causes emission of a visible light from the message key, wherein the dialing interface generates a message retrieval control signal in response to activation of the message key, and wherein the light source is responsive to a message waiting signal generated by the call management interface and received through the transceiver;
  - f) a transmitter attached to the housing and electrically connected to the transceiver; and

g) a receiver attached to the housing and electrically connected to the transceiver[.],

the message key presenting a distinct visual impression, apart from its emission of visible light, compared to its adjoining keys.

19. A message indicator for a telephone, the message indicator comprising:  
a light source that emits light when a message is waiting,  
a first key that, when manipulated by a user of the telephone, causes transmission of a message retrieval signal, and

a plurality of additional keys, wherein one or more of the additional keys is located adjacent to the first key, and the first key is visually distinct from its adjacent keys other than by its emission of light, and

wherein the light source is physically integrated with the key.

20. A telephone comprising:  
a message indicator light and a message access key, wherein the light is integrated with the key, the key comprising an upper surface whose substantial entirety emits light from the message indicator light.

21. The telephone set of claim 1, wherein the message key has a visibly different shape than its adjoining keys.

22. The telephone set of claim 1, wherein the message key is spaced apart from each of its adjoining keys by a distance that differs from the spacing between the adjoining key and its next adjoining key.

23. The telephone set of claim 1, wherein the message key is spaced apart from at least one of its adjoining keys by a distance that differs from the distance between the adjoining key and its next adjoining key.

**PENDING CLAIMS:**

1. A telephone set comprising:
  - a) a housing;
  - b) a dialing interface mounted in the housing, the dialing interface being in communication with a call management interface;
  - c) a plurality of dialing keys operably connected to the dialing interface;
  - d) a message alert and retrieval device, comprising a message key operably connected to the dialing interface, and a light source that causes emission of a visible light from the message key, wherein the dialing interface generates a message retrieval control signal in response to activation of the message key, and wherein the light source is responsive to a message waiting signal generated by the call management interface.
2. The telephone set of claim 1, wherein the message retrieval control signal comprises a predetermined series of dialing digits.
3. The telephone set of claim 2, further comprising a memory in operable connection with the dialing interface, wherein the memory stores data corresponding to the predetermined series of dialing digits for initiating the message retrieval control signal.
4. The telephone set of claim 3, further comprising a central processing unit operably connected to the dialing interface, the memory, and the call management interface.
5. The telephone set of claim 1, wherein the call management interface comprises a private branch exchange.
6. The telephone set of claim 1, wherein the dialing interface generates a dual tone multifrequency signal.
7. The telephone set of claim 1, wherein the telephone set and the call management interface are connected by a telephone line.
8. The telephone set of claim 1, wherein the message key comprises one of the plurality of dialing keys.

9. The telephone set of claim 1, wherein the message key comprises a touch-sensitive button.

10. The telephone set of claim 1, wherein the message key comprises a membrane switch.

11. The telephone set of claim 1, wherein the message key comprises a graphical icon.

12. The telephone set of claim 1, wherein the light source is located directly beneath the message key.

13. The telephone set of claim 1, wherein the light source comprises a light emitting diode.

14. The telephone set of claim 13, wherein the light emitting diode is mounted below an upper surface of the message key.

15. The telephone set of claim 1, wherein the light source comprises a light emitting diode and a light pipe assembly.

16. The telephone set of claim 1, wherein the light source comprises a matrix display assembly.

17. The telephone set of claim 1, wherein the light source comprises a liquid crystal display element.

18. A telephone set, comprising:  
a) a housing;  
b) a dialing interface mounted in the housing;  
c) a plurality of dialing keys attached to the housing and operably connected to the dialing interface;  
d) a transceiver electrically connected to the dialing interface and in communication with a call management interface;

e) a message alert and retrieval device attached to the housing, comprising a message key operably connected to the dialing interface, and a light source that causes emission of a visible light from the message key, wherein the dialing interface generates a message retrieval control signal in response to activation of the message key, and wherein the light source is responsive to a message waiting signal generated by the call management interface and received through the transceiver;

f) a transmitter attached to the housing and electrically connected to the transceiver; and

g) a receiver attached to the housing and electrically connected to the transceiver.

19. A message indicator for a telephone, the message indicator comprising:  
a light source that emits light when a message is waiting,  
a key that, when manipulated by a user of the telephone, causes transmission of a message retrieval signal,  
wherein the light source is physically integrated with the key.

20. A telephone comprising:  
a message indicator light and a message access key, wherein the light is integrated with the key.